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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
VANIK, DAVID L	

ART UNIT	PAPER NUMBER
1615	

DATE MAILED: 07/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/469,575	ALI ET AL.	
	Examiner	Art Unit	
	David L. Vanik	1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 November 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15* is/are pending in the application.

4a) Of the above claim(s) *1-5,7,8 and 10* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *6,9 and 11-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-15* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Receipt is acknowledged of the applicant's Request for Continued Examination filed on 11/26/2004. Receipt is also acknowledged of the applicant's amended claims and remarks filed on 11/26/2004.

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

   I. Claims 1-5, 8 drawn to a method for the mitigation of pet malodor, classified in class 424, subclass 76.2.

   II. Claims 6, 9, drawn to a product for mitigating or eliminating pet malodor, classified in class 424, subclass 76.6.

   III. Claims 7, 10, drawn to a device, a container for dosing a liquid malodor counteract on pet malodor, classified in class 424, subclass 76.2.

   IV. Claims 11-15, drawn to a method for the mitigation of pet malodor, classified in class 424, subclass 76.6.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II-III and Inventions I and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially

different process of using that product (MPEP § 806.05(h)). In the instant case, the process of using the product can be practiced with a materially different product. Specifically, a composition comprising zirconium hydroxide can be used for the mitigation of pet malodors.

3. Inventions II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the different inventions have distinct modes of operation and effects. Invention II is drawn to a composition for mitigating pet malodor, whereas Invention III is drawn to a device, a container for dosing a liquid malodor. Inventions II and III have different scopes, as Invention II is drawn to a composition and Invention III is drawn to a device. As such, a reference anticipating one group of inventions would not necessarily render the other inventions obvious.

4. Inventions I and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the different inventions have distinct effects. Invention I is drawn to a method for mitigating pet malodor generally, whereas Invention IV is drawn to a method for mitigating a particular type of pet malodor. Specifically, Invention IV is drawn to a method of mitigating pet malodor wherein said malodor are from ammonia formation

due to decomposition of urea present in animal waste. As such, a reference anticipating one group of inventions would not necessarily render the other inventions obvious.

5. Searching the inventions of Groups I – IV together would impose a search burden on the examiner. In the instant case, the search of a composition, a device, and two methods of using said composition would impose a search burden on the examiner.

6. Because these inventions are distinct for the reasons given above and the search required for each subset of Groups I – IV are not required for one another, restriction for examination purposes as indicated is proper.

7. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

8. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

9. During a telephone conversation with Ann Lee on 6/10/2005 a provisional election was made with traverse to prosecute the inventions of Groups II and IV, claims

6, 9, 11-15. After a conversation with Ann Lee on 6/10/2005, the examiner agreed to combine the claims of Inventions II and IV for prosecution. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-5, 7-8, 10 are withdrawn from further consideration by the examiner as being drawn to a non-elected invention.

Claim Objections

Claims 6 and 11 are objected to because of the following informalities: According to MPEP 608.01, material in parenthesis is only proper when referring to elements in a figure. Appropriate correction is required.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 6 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of US Patent 6,454,876 B1 ('876) in view of US Patent 5,359,961 ('961).

'876 claims a method for mitigating malodor comprising contacting said malodors with a composition comprising 0.1-3% water soluble polymers, 1-15% water soluble solvent, 0.01-5% of a fragrance, 0.01-1% of a surfactant, and water (Claim 1). Based on the formulations of Claim 1, the composition necessarily comprises at least 75% water (Claim 1).

The examiner notes the closed "consisting essentially of" language recited in the instant claim 6. However, as set forth in the instant specification and claim 12, the composition contemplates "aesthetic and/or functional additives." As defined by the instant specification, "aesthetic and/or functional additives" include fragrances and surfactants (pages 10-15 of the instant specification). In addition to comprising water, dispersible polymers, and volatile solvents, the composition advanced by claim 1 of '876 also comprises surfactants and fragrance. As set forth on pages 10-15 of the instant specification, both surfactants and fragrances were contemplated in applicant's invention. In other words, the instant specification allows for the presence of surfactants and fragrances in a deodorizing composition. Based on this, it is the examiner's position that the presence of surfactants and fragrances do not materially alter the deodorizing composition as described in the instant application.

'876 does not claim the presence of a dialkali metal tetraborate n-hydrate.

'961 teach an animal litter composition comprising borax (column 6, lines 22-29). According to '961, borax beneficially inhibits the growth of bacteria on animal litter, minimizing odor development (column 6, lines 22-29). Because borax has the ability to minimize odor development, one of ordinary skill in the art would have been motivated to add borax to the composition proposed by '876. Based on the teachings of '961, there is a reasonable expectation that a borax-based composition could minimize the growth of bacteria on animal litter, therefore minimizing odor development. As such, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate borax, an effective odor-minimizing compound, in the invention advanced by '876 in view of the teachings of '961.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 6, 9, and 11-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,183,655 ('655).

'655 disclose a composition for deodorizing animal waste comprising 0.003-50% pine oil and 0.06-50% of a borate-based compound, such as borax, in a liquid dispersion (Claim 1). Specifically, as set forth in Example 1, the composition advanced by '655 comprises over 75% of water, 15.0% of boric acid (equivalent to 0.097% borax), surfactants, 2.7% of a solvent, and pine oil (column 6, lines 35-48 and Claims 1-2). Borax decahydrate can be used as the as the dialkali metal tetraborate n-hydrate (column 4, line 42). Moreover, according to '655, "superabsorbent" polymers can be added to the composition (column 5, lines 61-64). The "superabsorbent" polymers are capable of entrapping liquid waste, thereby mitigating pet malodor (column 5, lines 61-64). The polymers advanced by '655 can also be in the form of water-soluble resins, such as polyvinyl alcohol (column 6, lines 18-23). Polyvinyl alcohol polymer resins can have a molecular weight below 2,000,000 Daltons. Since the deodorizing composition is present in an ammonia-controlling effective amount, it is the examiner's position that said composition would effectively mitigate odors caused by ammonia formation due to decomposition of urea present in animal waste (abstract).

The examiner notes the closed "consisting essentially of" language recited in the instant claims 6 and 11. However, as set forth in the instant specification and claim 12, the composition contemplates "aesthetic and/or functional additives." As defined by the instant specification, "aesthetic and/or functional additives" include fragrances and surfactants (pages 10-15 of the instant specification). In addition to comprising borax, water, dispersible polymers, and volatile solvents, the composition advanced by '655 also comprises surfactants and pine oil, a well-known fragrance (See US Patent 4,407,231, column 3, lines 25-30). As set forth on pages 10-15 of the instant specification, both surfactants and fragrances were contemplated in applicant's invention. In other words, the instant specification allows for the presence of surfactants and fragrances in a deodorizing composition. Based on this, it is the examiner's position that the presence of surfactants and fragrances do not materially alter the deodorizing composition as described in the instant application.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patent 5,992,351 is cited as a patent of interest in its disclosure of an animal litter composition comprising clay particles, borax, water-soluble polymers, water, and solvents.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David L. Vanik whose telephone number is (571) 272-3104. The examiner can normally be reached on Monday-Friday 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carlos Azpuru, can be reached at (571) 272-0588. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David Vanik, Ph.D.
Art Unit 1615

6/23/05

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